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Hearing:
November 30, 2005

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April 20, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PAHL, L.P.

Serial No. 75125078

Scott B. Schwartz of Cozen O'Connor, P.C. for PAHL, L.P.

Jeri J. Fickes, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Walters, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

PAHL, L.P. has appealed from the final refusal of the
trademark examining attorney to register



as a trademark for the following goods, as amended:

"[a]ccessories, namely, earrings and ornamental
lapel pins" in International Class 14;

"[c]lothing, namely, t-shirts, sweat shirts, knit shirts, jerseys, jackets, coats, shorts, pants, sweat pants, socks, shirts and rainwear; headwear; and footwear" in International Class 25; and

"[a]ccessories, namely, ornamental novelty buttons; ornamental novelty pins; and hair twists, namely, hair ornaments in the nature of fabric covered elasticized hair holders" in International Class 26.¹

The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark PHANTOMS (in standard character form) for "clothing; namely, t-shirts, sweatshirts, and sweat pants" in International Class 25,² that, as intended to be used on applicant's identified goods, applicant's mark is likely to cause confusion or mistake or to deceive.

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs. An oral hearing was held on November 30, 2005.

We affirm the Section 2(d) refusal of registration with respect to the goods in International Class 25 and reverse the Section 2(d) refusal with respect to the goods in International Classes 14 and 26.

¹ Application Serial No. 75125078, filed June 25, 1996, asserting a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 1980328, issued June 18, 1996. Section 8 and 15 filings accepted and acknowledged.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We initially consider the similarities between registrant's and applicant's goods in International Class 25. Both applicant and registrant identify t-shirts, sweat shirts and sweat pants in their identifications of goods, without any limitations. Thus, applicant's and registrant's goods are identical in part.

Applicant has argued that because "purchasers of goods bearing sports logos have come to expect that these goods have an association with the team which uses that particular logo ... it is unlikely that purchasers of the goods which have the distinctive 'PHANTOMS & Mask Design'

would be confused or deceived into believing that the source of the goods is other than the source of the sports team." Applicant adds that "sports fans specifically seek out goods bearing the 'PHANTOMS & Mask Design' and would not likely be satisfied with goods simply bearing the word 'Phantoms.'" Brief at pp. 6 - 7. Applicant's argument is premised on the assumption that all of applicant's customers are sports fans, and ignores those potential purchasers who are not sports fans and who would purchase applicant's goods because of the style, color or design of such goods. Also, applicant's argument ignores registrant's potential customers, i.e., those persons who may or may not be sports fans, but who are familiar with registrant's goods, and who, upon perceiving the term PHANTOMS on applicant's goods, will purchase applicant's goods rather than registrant's goods, believing they are registrant's goods. We therefore find applicant's argument unpersuasive.

Turning now to the International Class 14 and 26 goods, the evidence of record offered to show a relationship between applicant's and registrant's goods consists of (a) a first registration for, inter alia, t-shirts and earrings; (b) a second registration for goods and services in seven International Classes including

various clothing items such as t-shirts, sweatshirts and sweat pants, jewelry (which would include earrings) and hair ornaments; and (c) a printout of five pages "from www.bananarepublic.com ... showing a retail clothing source offering for sale both hair ornaments and jewelry," as well as "men's apparel" and "women's apparel," attached to the June 28, 2004 Office action. Brief at unnumbered p. 6. The printout shows that brooches, hair ties and earrings may be purchased through the same website.³

The examining attorney's evidence is insignificant in quantity and hence does not establish that a relationship exists between clothing items such as t-shirts, sweatshirts and sweat pants and applicant's International Class 14 and 26 goods. Moreover, there are obvious differences among the goods, with registrant's goods used to clothe the body and applicant's International Class 14 and 26 goods used for ornamentation and other purposes. We thus find that on the present record, the examining attorney has not established prima facie that registrant's and applicant's International Class 14 and 26 goods are similar or related to one another.

³ The printouts do not specifically state that t-shirts, sweatshirts or sweat pants, i.e., registrant's goods, are offered for sale on the website.

We next consider the similarities of the marks. We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Also, we are guided by the well-established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we are in agreement with the examining attorney that it is appropriate to give greater weight to the word portion of the mark when considering applicant's mark as a whole. It is by the word PHANTOMS that purchasers will refer to the goods, and it is the word, rather than the design feature or even the stylized lettering, that will have a greater impression on them. See *Id.* at 751 (it is well established that there is nothing improper in stating that, for rational reasons,

more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on the consideration of the marks in their entireties); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Moreover, the design element in applicant's mark, which applicant has characterized as a mask⁴ and which includes two eyes glaring through the mask, reinforces the meaning of the design in the mark as depicting a "phantom."⁵ In addition, the lettering in the mark is in a font consistent with the "phantom" label for the design.⁶

In view of the foregoing, we find that applicant's mark is identical in sound and connotation to the wording

⁴ In its reply brief at p. 2, applicant characterizes the mask as "highly reminiscent of a hockey goalie's mask." There is no evidence in the record to support applicant's characterization of the mask as "a hockey goalie's mask."

⁵ We take judicial notice of the following definition of "phantom" from the online version of *The American Heritage Dictionary of the English Language*; "1. a. Something apparently seen, heard, or sensed, but having no physical reality; a ghost or an apparition. ... 3. Something dreaded or despised." See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions).

⁶ In this regard, the examining attorney states: "There is an association between phantoms and masks: both represent hidden or unknown identities, therefore one of the ways of physically embodying a phantom is to show a mask wearing figure, such as the well-known depiction of the Phantom of the Opera." Brief at unnumbered p. 3.

in registrant's mark, which only consists of the term "phantoms" (in plural too).

We next consider the commercial impression of the marks. Applicant argues that "the overall commercial impression of Applicant's mark is strikingly different from the mark in the cited registration and wholly distinguished through the use of the distinctive 'Mask' design [and that] [t]he use of this 'Mask' design in Applicant's [mark] ... immediately conveys an association with the Philadelphia Phantoms ice hockey team." Brief at pp. 4 -5. We disagree. Applicant's argument is premised on the assumption that the mask design is well known, and there is no evidence of record to support applicant's assumption. Also, those who encounter both applicant's and registrant's goods and who know of applicant's mask design would likely believe that applicant endorsed or in some way was associated with registrant's goods in that both marks contain the term PHANTOMS. See *In re Dennison Mfg. Co.*, 229 USPQ 141 (TTAB 1986) ("It is a general rule that the addition of extra matter such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them."); *In re Riddle*, 225 USPQ 630 (TTAB 1985).

Rather, inasmuch as both marks refer to "phantoms," and PHANTOMS is the only wording in the marks, we find too that they are identical in commercial impression.

As for the appearance of the marks, we note that registrant's mark is in standard character form. As such, registrant is not limited to presentation of its mark in any particular stylization and may display its mark in various formats or fonts, in upper or lower case letters, and may, in choosing a particular form of display, end up with a mark very similar in appearance to the word in applicant's mark. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); 37 C.F.R. §2.52(a). Thus, we find too that the marks are similar in appearance.

Applicant points out that seven registrations exist which include the term PHANTOM or PHANTOMS "for the same or similar goods [and] eliminates any likelihood of confusion."⁷ Applicant maintains that "these other registrations demonstrate the narrow scope of protection afforded to the Registrant's mark"; and that consumers have

⁷ Applicant submitted a copy of each registration - and also a printout of certain pages of its website - for the first time with its appeal brief. The examining attorney did not object to the submission of the registrations or the printouts after the filing of the appeal, and, in fact, discussed the registrations in her brief. In view thereof, any objection the examining attorney may have had to the late-submission of the registrations and printouts is deemed waived by the examining attorney.

learned to distinguish between the coexisting 'Phantom' marks and can distinguish between them based on small differences in the marks and the goods." Brief at p. 9. Third-party registrations, however, by themselves, are entitled to little weight on the question of likelihood of confusion. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975). Moreover, as to the marks which are the subjects of these seven registrations, one is for "soccer balls,"⁸ which are not goods for which applicant seeks registration. Additionally, four of the registrations include additional wording which makes the connotations and commercial impressions of these marks different from those of applicant's mark.⁹ The remaining two registrations, i.e., for PHANTOMS TORONTO (and design)

⁸ Registration No. 2864587 for PHANTOM.

⁹ These four marks are Registration No. 2531861 for PHANTOM HORSE (and design), Registration No. 2685252 for PHANTOM FIREWORKS.COM (and design), Registration No. 2553349 for FORT PHANTOM and Registration No. 2922270 for PHOEBUS PHANTOMS.

and TORONTO PHANTOMS,¹⁰ are simply insufficient in number to be persuasive.

Applicant also argues that its goods are intended to be sold at "games and in sporting goods stores and department stores"; and that "[p]otential consumers seeing the 'PHANTOMS & Mask Design' on clothing, headwear, footwear and accessories will immediately believe and understand that the source of the good is the same as the Philadelphia Phantoms ice hockey team" and not "consider Applicant's goods sold under its mark to be the same goods or emanating from the same source as t-shirts, sweatshirts and sweat pants sold under the mark "PHANTOMS" alone." Brief at p. 5. However, applicant has not limited its identification of goods to specify that its goods will only be sold at games and in sporting goods stores and department stores. Rather, we must consider that applicant's goods may be sold in all channels of trade that are appropriate for the sale of applicant's clothing, including general clothing stores, and not merely the specific channels of trade in which applicant's represents

¹⁰ Registration Nos. 2745968 and 2541755, respectively.

its clothes are intended to be sold. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).¹¹

Thus, in view of the foregoing, we find that applicant's mark and the cited marks are similar or even identical in sound, appearance, connotation and commercial impression.

We therefore hold that (a) with respect to the goods in International Class 25, when applicant's mark and the registered mark PHANTOMS are used on goods which are identical in part and sold to ordinary purchasers, confusion is likely; and (b) with respect to the goods in International Classes 14 and 26, the examining attorney has not met her burden of demonstrating that the goods are related so that consumers who would come into contact with both would likely be confused by applicant's use of its mark. Additionally, we note that on a different record than the one before us, we might have arrived at a

¹¹ The examining attorney, in discussing this argument, refers to printouts of applications and registrations which show "teams with variant marks registered both with and without designs." Our inspection of these printouts reveals that a number of them are the subject of pending applications, and are not registrations. The probative value of these applications is minimal because they are only evidence that the applicants listed therein have applied for registration for marks on the identified goods. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002). Of the few remaining registrations, they fail to show "a common practice of sports teams using variations of a core mark" Brief at unnumbered p. 3.

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different result with respect to the goods in International Classes 14 and 26.

DECISION: The refusal to register the mark under Section 2(d) of the Trademark Act is affirmed for the goods in International Class 25 and is reversed for the goods in International Classes 14 and 26.